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09/124,043	07/29/1998	JOHN S. HENDRICKS	5212	6239

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EXAMINER

GRANT, CHRISTOPHER C

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 08/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/124,043

Applicant(s)

HENDRICKS ET AL.

Examiner

Christopher Grant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-136 is/are pending in the application.
- 4a) Of the above claim(s) 66-116 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22,25,26,28-65 and 117-136 is/are rejected.
- 7) ☒ Claim(s) 23,24 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4,10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 32-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-23, 25-28 and 32 of U.S. Patent No. 5,600,364. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions of the same subject matter, varying in breadth or scope. For example, note the following relationship between the current application claim 39 and patented claim 21:

a) the claimed "*An apparatus for use in a cable television program delivery system...*" (lines 1-2) of the current application claim 39 corresponds to the "*A network controller for use with a cable headend...*" (lines 1-5) of patented claim 21;

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b) the claimed “*means for gathering programs watched data...*” (lines 6-7) of current application claim 39 corresponds to the “*means for gathering programs watched data...*” (lines 6-8) of patented claim 21;

c) the claimed “*means for storing...database*” (lines 8-9) of current application claim 39 corresponds to “*means for storing...database.*” (lines 9-10) of patented claim 21;

d) the claimed “*means for accessing...programs watched data*” (lines 10-11) of current application claim 39 corresponds to “*means for accessing...programs watched data*” (line 11) of patented claim 21; and

e) the claimed “*means for counting....*” (lines 12-15) of current application claim 39 corresponds to the “*means for counting...*” (lines 12-17) of patented claim 21; and

Therefore, it would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter, varying in breadth. In particular the subject matter of application claim 39 is broader and inclusive in the subject matter of patented claim 21.

The claimed subject matter of application claims 40, 41 and 42 correspond to the subject matter of patented claims 22, 23 and 25 respectively.

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The claimed subject matter of application claim 43 and patented claim 26 are not patentably distinct from each other because they are different definitions of the same subject matter, varying in breadth or scope. In particular the subject matter of application claim 43 is broader and/or inclusive in the subject matter of patented claim 26.

The claimed subject matter of application claims 44 and 45 correspond to the subject matter of patented claims 27 and 28.

As for application claim 46, it would have been obvious to one of ordinary skill in the art to modify the system to include CSMA/CD protocol because it is a notoriously well known communication protocol that provides efficient packet transmission, fair access to a network and improved collision detection.

The claimed subject matter of application claim 47 correspond to the preamble "cable headend delivery system" and related subject matter of patented claim 26.

As for application claim 48, it would have been obvious to one of ordinary skill in the art to modify the system to include the programs watched information to be transmitted over a telephone network because it is a notoriously well known efficient, inexpensive and readily available (i.e. most homes of existing telephone lines) communication technique used in the art to transmit data from a user terminal to a central facility. Further see cited reference Durden at col. 9, lines 6-30.

The claimed subject matter of application claim 49 and patented claim 32 (or patented claim 21) are not patentably distinct from each other because they are different definitions of the same subject matter, varying in breadth or scope. In particular the subject matter of application claim 49 is broader and/or inclusive in the subject matter of patented claim 32 (or patented claim 21).

The claimed subject matter of application claim 50 correspond to the subject matter of patented claim 22.

The claimed subject matter of application claim 59 and patented claim 32 are not patentably distinct from each other because they are different definitions of the same subject matter, varying in breadth or scope. In particular the subject matter of application claim 59 is broader and/or inclusive in the subject matter of patented claim 32.

The claimed subject matter of application claim 32 and patented claim 21 are not patentably distinct from each other because they are different definitions of the same subject matter, varying in breadth or scope. In particular the subject matter of application claim 32 is broader and/or inclusive in the subject matter of patented claim 21.

The claimed subject matter of application claim 33 correspond to the subject matter of patented claim 22.

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The claimed subject matter of application claims 34, 35 and 37 correspond to the subject matter of patented claims 23 or 25.

The claimed subject matter of application claim 36 correspond to the subject matter of patented claims 24 or 28.

As for application claim 38, it would have been obvious to one of ordinary skill in the art to modify the system to include a telephone because it is a notoriously well known efficient, inexpensive and readily available (i.e. most homes of existing telephone lines) communication technique used in the art to transmit data from a user terminal to a central facility. Further see cited reference Durden at col. 9, lines 6-30.

The claimed subject matter of application claim 51 and patented claim 21 are not patentably distinct from each other because they are different definitions of the same subject matter, varying in breadth or scope. In particular the subject matter of application claim 51 is broader and/or inclusive in the subject matter of patented claim 21.

The claimed subject matter of application claims 52-58 correspond to the subject matter of patented claims 21-27 respectively.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

or

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 7-12, 15-18 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Durden et al. (Durden) (5,003,384).

Considering claim 1, Durden discloses an apparatus that gathers information related to television viewing comprising:

- a) a first processor (20) that provides information related to which television programming was viewed (col. 6, lines 57-62 and col. 5, lines 28-40)
- b) a first memory (21) that stores the information;
- c) a second processor (18) that receives the information from the first memory (21) and arranges the information as programs watched data (col. 9, lines 7-54); and
- d) a second memory (19) that stores the programs watched data.

Claim 7 is met by the unique identification number and/or unique serial number for each set top terminal as described at col. 5, lines 12-27. Furthermore, each set top terminal has its own address as described at col. 6, lines 34-42.

Claims 8-9 are met by the data collected by each set top terminal that is transmitted to the second processor (18), wherein the programs watched matrix have a dimension of at least 1.

See col. 9, lines 7-54 and also viewing “table” at col. 5, lines 11-40.



Claim 10 is met by processor (20) and memory (21) that are contained in a set top terminal.

Claims 11 and 12 are met by processor (18) and the memory (19) which are contained in at a central facility (e.g. headend or operations center) remote from the set top terminal.

Considering claim 15, Durden discloses an apparatus that gathers programs watched data comprising:

- a) a plurality of terminals (15) connected to televisions and a program delivery system (5,6,8,10), each terminal including a memory (21) that stores program access information (pay-per-view event information, col. 6, lines 48-65); and
- b) a receiver (18) coupled to the plurality of terminals, the receiver receiving the program access information, wherein the program access information is stored as program watched data (col. 9, lines 7-54).

Claim 16 is met by the data collected by each set top terminal, wherein the programs watched matrix have a dimension of at least 1. See also viewing "table" at col. 5, lines 11-40.

Claim 17 is met by the unique identification number and/or unique serial number for each set top terminal as described at col. 5, lines 12-27. Furthermore, each set top terminal has its own address as described at col. 6, lines 34-42.

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Claim 18 is met by the “global command” described at col. 6, lines 50-54.

Claim 22 is met by the data collected by each set top terminal that is transmitted to the second processor (18), wherein the programs watched matrix have a dimension of at least 1. See col. 9, lines 7-54 and also viewing “table” at col. 5, lines 11-40.

5. Claims 1, 13, 60, 117-120, 125-130, 135 and 136 are rejected under 35 U.S.C. 102(e) as being anticipated by McMullan (5,251,324).

Considering claims 1 and 13, McMullan discloses an apparatus (set top terminal) (figures 3-4) that gathers information to television viewing habits comprising:

- a) a first processor (400, figure 3) that provides information related to which television programming was viewed (col. 10, line 59- col. 11, line 57)
- b) a first memory (470) or an inherent temporary register associated with processor (400) that stores the information;
- c) a second processor (504, figure 4) that receives the information from the first memory (470, or the register) and arranges the information as programs watched data (col. 10, line 59 – col. 11, line 57 and col. 23, line 65 – col. 24, line 61); and
- d) a second memory (503, figure 4) that stores the programs watched data.

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As for claim 60, McMullan discloses a method of gathering programs watched information from a set top terminal that acquires programs from a programming source comprising:

- a) receiving a plurality of programs at the set top terminal (col. 10, lines 59-65);
- b) selecting and monitoring a program at the set top terminal from the plurality of programs (col. 10, lines 65-68, col. 11, lines 49-52 and col. 24, lines 1 –17);
- c) generating programs watched information related to the selected program (col. 23, line 65 – col. 24, line 61);
- d) storing the generated programs watched (memory 503) (col. 24, lines 49-61).

Considering claims 117, 125-127 and 135-136 McMullan discloses a system and corresponding method for gathering data related to television programming comprising:

- a) a remote site (110-figure 1, details in figure 2) that provides television programming;
- b) a terminal (120) (figure 1, details in figures 3-4) operably coupled to the remote site, the terminal receives television programs and sends television programs to the television (130) (figure 1);
- c) a control (e.g. remote control, col. 11, lines 19-25) operably coupled to the terminal....;
- d) a processor (400-figure 3 and/or 504-figure 4) that processes commands to produce program access information (col. 10, line 59 – col. 11, line 57 and col. 23, line 65 – col. 24, line 61); and
- e) a memory (470-figure 3, and/or 503-figure 4) that stores the programs access information.

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Claims 118 and 128 are met by the remote site (110) that is a headend or an operations center.

Claims 119 and 129 are met by an inherent cable modem that transmits data upstream on the cable network as described at col. 14, lines 1-59 and throughout the entire reference.

Claims 120 and 130 are met by receiver (322 or 321– figure 1), second processor (322 or 321) and database (310 or 305 –figure 1, col. 9, line 18 – col. 10, line 59).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14, 25, 26 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durden and McMullan Jr. (McMullan) (5,251,324).

Considering claims 14 and 25, Durden fails to specifically disclose the second processor or a controller sends a polling message to the set top terminal as recited in the claims.

McMullan discloses a processor or controller at a headend (a central facility) that sends a polling message to one or more set top terminals for the advantage of providing a central device that automatically controls communication with terminals (i.e. the central device initiates communication and automatically retrieves data). See col. 28, line 11 – col. 30, line 21.

It would have been obvious to one of ordinary skill in the art to modify Durden's

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system to include a second processor or a controller to send a polling message to the set top terminal, as taught by McMullan, for the advantage of providing a central device that automatically controls communication with terminals (i.e. the central device initiates communication and automatically retrieves data).

Claim 26 is met by the combined systems of Durden and McMullan, wherein McMullan discloses cyclic polling disclosed throughout the entire reference including but not limited to col. 29, lines 26-42.

Claim 28 is met by the combined systems of Durden and McMullan, wherein McMullan discloses re-programming the polling time disclosed in column 28.

Claims 29 and 30 are met by the combined systems of Durden and McMullan, wherein McMullan discloses that the processor or controller is located at a central facility such as headend or operations center.

8. Claims 2-6, 19-21 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durden.

Considering claims 2-6 and 19-21, McMullan discloses that the programs watched data includes program channel and time (col. 24, lines 1-61). However, McMullan fails to specifically disclose program title, date, time, category and the columns and rows arrangement as recited in the claims.

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The Examiner takes Official Notice that it is notoriously well known in the art to collect programs watched data that include any program attribute such as the program title, time, date, category and table arrangement (columns and rows) for the advantage of providing a more precise measurement of the programs watched for statistical analysis (e.g. Nielsen and/or Arbitron ratings). Further, column and row arrangement facilitates easy viewing.

It would have been obvious to one of ordinary skill in the art to modify McMullan's system to include the programs watched data to include program title, time, date, category and that they are arranged in table format (columns and rows) for the advantages of providing a more precise measurement of the programs watched for statistical analysis and for easily viewing items in a row and column or table format.

Considering claim 31, Durden fails to specifically disclose the programs watched data is stored as group programs watched data as recited in the claim.

The examiner takes Official Notice that it is notoriously well known in the art to collect data into groups such as by age, city, county, state, country etc. The advantage of this technique is that it provides detail statistical analysis for content providers so that the content providers can tailor the delivery of advertisements and/or programs to subscribers.

It would have been obvious to one of ordinary skill in the art to modify Durden's system to include programs watched data to be stored as group programs watched data, for the advantage of collecting detail statistical analysis for content providers so that the content providers can tailor the delivery of advertisements and/or programs to subscribers.

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9. Claims 61-64, 121-124 and 131-134 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMullan.

Considering claims 61-64, McMullan discloses generating and storing the programs watched information in a module (490) (illustrated in figure 3 and more detail in figure 4) that is separate from the regular set top terminal components. However, he fails to specifically disclose that the steps of monitoring, generating and storing occurs in a card or in a network controller located at a cable television headend or operations center as recited in the claims.

Claims 61-64 call for the method steps to occur separate or outside the set top terminal. McMullan clearly discloses that some of the functions do not occur in the regular portion of the set top terminal and that all the functions may occur in the set top terminal (col. 11, lines 1-37). Separate components, modules and/or cards provide easy replacement of parts. Furthermore, the particular location of the components that perform one or more functions (such as monitoring, generating and storing) of processing programs watched data is dependent on the desire of the skilled engineer. Note also that cited reference Durden discloses some of functions of processing programs watched data occurs outside the set top terminal (i.e. functions performed by components (8,19) occur outside and/or remote from set top terminal 15).

Therefore, it would have been obvious to one of ordinary skill in the art to modify McMullan's system to include monitoring, generating and storing to occur separate from the set top terminal such as in a card or in a network controller located at a cable television headend or operations center for the advantages of providing an easy technique to replace components and/or to share processing functions of a set top terminal at a remote central processor.

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Considering claims 121-124 and 131-134, McMullan discloses that the programs watched data includes program channel and time (col. 24, lines 1-61). However, McMullan fails to specifically disclose program title, date, category and the table arrangement as recited in the claims.

The Examiner takes Official Notice that it is notoriously well known in the art to collect programs watched data that include any program attribute such as the program title, date, category and table arrangement for the advantage of providing a more precise measurement of the programs watched for statistical analysis (e.g. Nielsen and/or Arbitron ratings). Further, column and row arrangement (table) facilitates easy viewing.

It would have been obvious to one of ordinary skill in the art to modify McMullan's system to include the programs watched data to include program title, date, category and table arrangement for the advantages of providing a more precise measurement of the programs watched for statistical analysis and for easily viewing items in a row and column or table format.

***Allowable Subject Matter***

10. Claims 23, 24 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



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***Election/Restrictions***

11. Applicant's election with traverse of Group I in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the search and examination of the entire application could be made without serious burden.

After reviewing the application, the Examiner posits that claims 32-38 and 51-58 should have been included into Group 1. However, the search required for Groups II (remaining claims 72-108 and 110-116), III and IV are not required for Group I and they have a separate status in the art as shown by their different classifications.

The requirement is still deemed proper and is therefore made FINAL.

12. Claims 66-116 are withdrawn from further consideration as being drawn to a nonelected Groups II-IV.

13. Claims 1-65 and 117-136 have been considered on the merits.

***Conclusion***

14. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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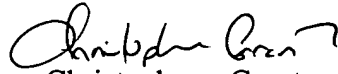
Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Grant whose telephone number is (703) 305 4755. The examiner can normally be reached on Monday-Friday 8:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872 9314 for regular communications and (703) 872 9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

  
Christopher Grant  
Primary Examiner  
Art Unit 2611

CG  
July 28, 2003